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EXAMINER	
STIBLEY, MICHAEL R	

ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,048	ANAND ET AL.	
	Examiner	Art Unit	
	MICHAEL R. STIBLEY	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6,8-10,12,13,18-21 and 25-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6,8-10,12,13,18-21 and 25-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/21/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

1. Applicant's remarks of 10/20/2008 are based on the newly amended claims and such arguments are fully addressed in the present Office Action as featured below.

Applicant argues that the claim objection of Claims 8-10, 12-13, 25-28 and 32-34 is improper. The claim objection stands. Examiner directs Applicant to MPEP 608.01(n) II and III. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. Because it is possible to perform the methods of Claims 1 and 18 without the computer-readable storage mediums storing one or more sequences of instructions of the improper dependent claims, the dependent claims 8-10, 12-13, 25-28 and 32-34 fail to further limit the parent claims. Applicant is required to cancel the claim(s) or amend the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In light of claim amendments the previous §101 rejection of Claims 1-3, 5-6, 18-21, and 29-31 is hereby withdrawn.

Necessitated by amendment, a new grounds of rejection follows. Applicant's remaining remarks are thus moot.

Therefore, Applicant's request for allowance and withdraw of the most previous Office Action have been carefully considered and respectfully denied in view of the current response. **Thus, the current Office Action is made FINAL.**

DETAILED ACTION

2. This Office Action is in response to the remarks and claim amendments filed on 10/20/2008.

Election/Restriction Requirement

3. Claims 1-3, 5-6, 8-10, 12-13, 18-21, 25-28, and 29-34 are currently pending in the instant application and have been examined. On June 24, 2008, Applicant elected Group I, in response to a restriction requirement of 6/20/2008, without traverse. The Restriction Requirement is hereby made FINAL.

Claim Objections

4. 37 C.F.R. § 1.75 Claim(s) provides:(a) The specification must conclude with a claim particularly pointing out and
distinctly claiming the subject matter which the applicant regards as his invention or discovery.
(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.
c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(j). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

5. Claims 8-10, 12-13, 25-28 and 32-34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 8-10, 12, 13, 25-28, and 32-34 are product claims (i.e. computer-readable media) that refers back to method Claims 1-3, 5, 6, 18-21, and 29-31. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since the parent claims are method claims comprising a series of steps and the above claims fail to add, delete, or change any of these steps, the above claims fail to further limit their parent claims. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-3, 5, 8-10, 12, 18-21 and 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Shamin Naqvi et al (NAQVI)(WO 97/21183).**

As per Claims 1, 8, 18-21 and 25-34: **NAQVI** teaches: A method for determining which advertisements to include with electronic content delivered to users over a network, comprising an electronic content provider:

> See at least "…the content page is provided by a home page dispatcher, a search engine, or a generic HTML content provider in response to the query…" Page 9 lines 25-30

receiving a plurality of advertisements from a plurality of advertisers;

See at least "…server containing a plurality of advertisements…" Pg 9 lines 10-15 See also "…the operation of the prime space manager is based on a set of contracts that were accepted when the advertisers placed their advertisements with the system…" Pg 16 lines 20-25

storing revenue information that indicates potential revenue amounts for the plurality of advertisements, wherein each of the plurality of advertisements is associated with corresponding delivery criteria;

See at least "…Let P1…Pn denote the contract values associated with the corresponding advertisements (P1 denotes the contract value associated with advertisemetn Ai, as a function of the price paid by the advertiser)..." Pg 47 lines 17-21 See also abstract "…the advertisements can be made to satisfy a set of contraints requested by the advertiser as well as the constraints of the publisher of the page…" See also Page 5 lines 10-15

associating each of the plurality of advertisements with a priority class, wherein the priority class associated with each of the plurality of advertisements indicates whether the corresponding advertisement is the subject of a guaranteed contract;

See at least "…it is a further object of the present invention to provide a method and system for advertising in which advertisers can be guaranteed that their advertisements will be displayed a certain number of times or in a particular manner or under particular circumstances…" Pg 3 line 30 – Pg 4 line 4

receiving, from a client that is not one of the plurality of advertisers, a request to provide over the network a piece of electronic content that includes a slot for an advertisement;

See at least abstract "…the advertisements can be made to satisfy a set of contraints requested by the advertiser as well as the constraints of the publisher of the page…" See also Page 5 lines 10-15 See also "…for purposes fo the present invention, it is assumed that here are three broad classes of publishers that can utilize the advertising features of the present invention. A publisher can include virtually anyone that provides content to the network…" Pg 21 lines 5-10 See also "…the purpose of the mixer is to take publishers' content and advertisements and combine them together so that the content and the advertisements are mixed on the same page…" Pg 32 lines 10-16 See also "…no advertisements are shown unless it can be determined that the advertisements are in some way focused or related to the content of what the user requested…" Pg 27 lines 5-10

and in response to receiving the request, performing the steps of: comparing slot attributes of the slot with the delivery criteria of the plurality of advertisements to determine a subset of the plurality of advertisements that qualify for inclusion in the slot, wherein the slot attributes of the slot include at least one of (a) the nature of the piece of electronic content, (b) the size of the slot within the piece of electronic content, or (c) the placement of the slot within the piece of electronic content;

See at least "…no advertisements are shown unless it can be determined [comparing slot attributes of the slot with the delivery criteria] that the advertisements are in some way focused [nature] or related to the content of what the user requested…" Pg 27 lines 5-10 See also "…the layout manager evaluates each and every rule in its rule base to figure out which rule is the best for a given piece of data. The rules are evaluated at step 54 by calculating a meta and a target function cost. The meta template is the template that describes what the

layout is about. For example, the template may provide that there are only five places [placement of the slot within the piece of electronic content] for advertisements in a particular layout…" Pg 30 lines 8-15 See also "…the variables that are expressed in the rules are based on a number of parameters including the size of the text, the amount of text, the size of the maps, the size of the images, and the size of the advertisement…" Pg 13 lines 10-15 See also "…The prime space manager has a prime space algorithm that accepts as inputs the list of relevant ads that are related to the query at hand, the size of the prime space, [size of the slot within the piece of electronic content] and the list of all ad contracts. The prime space manager then looks at all the ad contracts and determines which advertisements to show to the user…" Pg 46 lines 24-30

filtering, out of the subset of the plurality of advertisements, advertisements that have a priority class that is lower than the priority class of any other advertisement that belongs to the subset;

See at least "…no advertisements are shown unless it can be determined that the advertisements are in some way focused or related to the content of what the user requested…" Pg 27 lines 5-10, See also "…displays the content pages with focused, targeted advertisements as part of the page…" abstract See also "…advertisements are more focused and targeted…" Pg 3 lines 22-27 See also "…the advertisements can be made to satisfy a set of constraints by the advertiser, as well as the constraints of the publisher of the page..." Pg5 lines 10-15 See also "…no advertisements are shown unless it can be determined [filtering] that the advertisements are in some way focused or related to the content of what the user requested…" Pg 27 lines 7-10 See also "…advertisers will be assured of "fair" [filtered treatment] in the sense that their advertisements will be presented to targeted users

in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]..." Pg 48 lines 4-10 See also "…the fairness guarantees of an algorithm for the system ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement…" Pg 54 lines 1-31

selecting an advertisement from the subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts.

See at least "…advertisers will be assured of "fair" [filtered treatment] in the sense that their advertisements will be presented to targeted users in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]..." Pg 48 lines 4-10 See also "…the fairness guarantees of an algorithm for the system ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement…" Pg 54 lines 1-31

As per Claims 2 and 9: **NAQVI** teaches: wherein: each advertisement of the plurality of advertisements has a corresponding delivery obligation and a corresponding potential revenue amount.

See at least abstract "…the advertisements can be made to satisfy a set of contraints requested by the advertiser as well as the constraints of the publisher of the page…" See also Page 5 lines 10-15

As per Claims 3 and 10: **NAQVI** teaches: wherein the selecting an advertisement to include further comprises: selecting a first advertisement instead of a second advertisement if the corresponding potential revenue amount of the first advertisement is higher than the corresponding potential revenue amount of the second advertisement.

See at least "…advertisers will be assured of "fair" [filtered treatment] in the sense that their advertisements will be presented to targeted users in a manner that is commensurate with the fees they were charged. Fairness means equal access as well as controlled access ensuring that advertisers who pay more are more accessible than those who pay less [lower priority class]..." Pg 48 lines 4-10 See also "…the fairness guarantees of an algorithm for the system ensures that the advertisements are displayed in a way that is proportional to the fee charged for that advertisement…" Pg 54 lines 1-31

As per Claims 5 and 12: **NAQVI** teaches: wherein the piece of electronic content is a web page.

See at least "…web…" Pg 2 line 10; See also "…content page…" Pg 9 lines 15-20

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 6 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shamin Naqvi et al (NAQVI)(WO 97/21183) in view of Official Notice.

As per Claims 6 and 13: **NAQVI** teaches the method of Claim 1 as discussed above but fails to disclose: wherein the piece of electronic content is a video stream.

In general, NAQVI teaches a system and method for providing content and advertisements to users of the internet

Although NAQVI teaches electronic content, **nevertheless, NAQVI** does not expressly disclose wherein the piece of electronic content is a video stream.

HOWEVER, Official Notice is taken that it is well known to a person of ordinary skill in the art that electronic content includes a video stream

THEREFORE, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the teachings of **Official Notice** with **NAQVI** so as to provide a system and method for providing content, ie video stream and advertisements to

users of the internet **thereby** allowing advertisers and publishers target market audiences who are interested in particular types of content and serve them with similar advertisements so as to maximize advertising dollars and have more effective advertising campaigns.

Conclusion

10. THIS ACTION IS MADE FINAL See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Monday-Friday 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES W. MYHRE can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL R. STIBLEY/
Examiner, Art Unit 3688
Monday, February 02, 2009

/Jean Janvier/
Primary Examiner, Art Unit 3688